



STATUTORY INSTRUMENTS

S.I. No. 622 of 2007

EUROPEAN COMMUNITIES (PROVISION OF SERVICES
CONCERNING TRADE MARKS AND INDUSTRIAL DESIGNS)
REGULATIONS 2007

(Prn. A7/1687)

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I, MICHEÁL MARTIN, Minister for Enterprise, Trade and Employment, in exercise of the powers conferred on me by section 3 of the European Communities Act 1972 (No. 27 of 1972) and for the purpose of—

(a) giving full effect to Article 49 of the Treaty establishing the European Community with regard to freedom to provide services to which the following regulations relate, and

(b) making such incidental, supplementary and consequential provisions as appear to me to be necessary for the purpose of those regulations,

hereby make the following regulations:

Citation.

1. These Regulations may be cited as the European Communities (Provision of Services Concerning Trade Marks and Industrial Designs) Regulations 2007.

Definitions.

2. In these Regulations—

“Act of 1996” means the Trade Marks Act 1996 (No. 6 of 1996);

“Act of 2001” means the Industrial Designs Act 2001 (No. 39 of 2001).

Amendment of section 83 of Act of 1996.

3. Section 83 of the Act of 1996 is amended—

(a) in subsection (1), by substituting the following paragraph for paragraph (b):

“(b) who is—

(i) a registered trade mark agent, or

(ii) a person referred to in subsection (4A) of section 85 and the relevant provisions of that section with regard to the person’s acting as agent in the foregoing circumstances are complied with.”, and

(b) by substituting the following subsection for subsection (2):

*Notice of the making of this Statutory Instrument was published in
“Iris Oifigiúil” of 14th September, 2007.*

“(2) A person referred to in paragraph (b)(i) or (ii) of subsection (1) who is duly authorised by another person under that section to act as his agent may (subject to any provision to the contrary in any agreement between the person so authorised and the other person), on giving notice to the Controller and the other person, cease to act as agent for the other person.”.

Amendment of section 85 of Act of 1996.

4. Section 85 of the Act of 1996 is amended by inserting the following subsections after subsection (4):

“(4A) Notwithstanding subsections (1) to (3) but subject to subsections (4B) to (4E), a person established in a Member State of the European Community (other than the State) and qualified under the law of that state to act as a trade mark agent in that state may carry on the business of acting as a trade mark agent for others in connection with the registration of a trade mark or any procedure relating to a registered trade mark.

(4B) On or before the first occasion on which a person acts, in reliance on subsection (4A), on behalf of another before the Controller in connection with the registration of a trade mark or any procedure relating to a registered trade mark, the person shall provide to the Controller such evidence as may be prescribed relating to—

- (a) the person’s being established in another Member State of the European Community,
- (b) the person’s being qualified under the law of that state to act as a trade mark agent in that state, and
- (c) whichever of the following is appropriate—
 - (i) the person’s nationality, or
 - (ii) the person’s falling within paragraph (b) of the definition of ‘person’ in subsection (4F).

(4C) In acting, in reliance on subsection (4A), on behalf of another in connection with the registration of a trade mark or any procedure relating to a registered trade mark, the person shall use the applicable professional title (if any) but its use in the State shall be subject to the following requirements—

- (a) the title is to be expressed in the official language or one of the official languages of the Member State referred to in subsection (4A), and
- (b) in a case where the language in which the title is expressed is also an official language of the State, the use of the title

is not such as is likely to be understood as indicating that the person is a trade mark agent registered under this Act.

(4D) It shall be sufficient compliance with subsection (4C)(b) if the use of the title concerned is accompanied by an indication of the Member State in which the person concerned is established as a trade mark agent.

(4E) If there is no applicable professional title, then the person, in acting as mentioned in subsection (4C), shall indicate that the person possesses the applicable qualifications and those qualifications shall be expressed in the official language or one of the official languages of the Member State referred to in subsection (4A).

(4F) In this section—

‘applicable professional title’, in relation to a person, means the professional title that, by virtue of the person’s being qualified to act as a trade mark agent in the Member State referred to in subsection (4A), the person is entitled to use in that state;

‘applicable qualifications’, in relation to a person, means the qualifications that the person must possess, under the law of the Member State referred to in subsection (4A) so as to be qualified to act as a trade mark agent in that state;

‘person’ means—

- (a) in the case of an individual, a national of a Member State of the European Community, and
- (b) in the case of a person which is not an individual, a company or firm (within the meaning of Article 48 of the Treaty establishing the European Community) formed in accordance with the law of a Member State of the European Community and having its registered office, central administration or principal place of business within the European Community.”.

Amendment of section 86 of Act of 1996.

5. Section 86(1) of the Act of 1996 is amended by substituting the following paragraphs for paragraphs (a) and (b):

“(a) resides in the European Community,

(b) has a place of business in the European Community.”.

Amendment of section 91 of Act of 1996.

6. Section 91 of the Act of 1996 is amended by substituting the following subsection for subsection (3):

“(3) In this section ‘registered agent’ means—

- (a) a registered trade mark agent;
- (b) a partnership entitled to describe itself as a firm of registered trade mark agents;
- (c) a body corporate entitled to describe itself as a registered trade mark agent; or
- (d) a person to whom section 85(4A) applies.”.

Amendment of section 87 of Act of 2001.

7. Section 87 of the Act of 2001 is amended by substituting the following subsection for subsection (3):

“(3) In subsection (2) ‘registered agent’ means:

- (a) a registered trade mark agent;
- (b) a registered patent agent; or
- (c) a person to whom section 106(3) of the Patents Act 1992 or section 85(4A) of the Trade Marks Act 1996 applies.

Amendment of section 88 of Act of 2001.

8. Section 88 of the Act of 2001 is amended—

(a) by substituting the following subsection for subsection (1):

“(1) Whenever, under this Act, an act has to be undertaken by or done to a person in connection with the registration of a design or any procedure relating to a registered design or a design right, the act may be undertaken by or done to an agent—

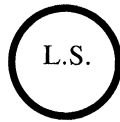
- (a) who is authorised by that person orally or in writing; and
- (b) who is—
 - (i) a registered patent agent or a registered trade mark agent, or
 - (ii) a person referred to in subsection (3) of section 106 of the Patents Act 1992 or subsection (4A) of section 85 of the Trade Marks Act 1996 provided—
 - (I) the relevant provisions of that section 106 or 85, as the case may be, with regard to such person acting as agent for the first-mentioned person in this subsection are complied with (disregarding, for this purpose, the fact that the act concerned relates to a

registered design or design right and not to a patent or trademark), and

- (II) such person is qualified under the law of the state referred to in subsection (3) of that section 106 or subsection (4A) of that section 85 to act in relation to matters concerning the registration of a design or, as the case may be, in relation to procedures relating to registered designs or design rights.”, and

(b) by substituting the following subsection for subsection (2):

“(2) A person referred to in paragraph (b)(i) or (ii) of subsection (1) who is duly authorised by another person under that subsection to act as his or her agent may (subject to any provision to the contrary in any agreement between the person so authorised and the other person), on giving notice to the Controller and the other person, cease to act as agent for the other person.”.



GIVEN under my Official Seal,
5 September 2007

MICHEÁL MARTIN.
Minister for Enterprise, Trade and Employment.

EXPLANATORY NOTE

(This note is not part of the Instrument and does not purport to be a legal interpretation)

These Regulations, made pursuant to the European Communities Act, 1972, amend certain provisions of the Trade Marks Act, 1996 and the Industrial Designs Act, 2001 in order to allow a person, established in another Member State of the European Community and qualified under the law of that State to act as a trade mark agent, to act for another person in relation to trade mark matters before the Controller of Patents, Designs and Trade Marks.

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